REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 11, 21, and 31 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-47 are now pending in this application. Each of claims 1, 11, 21, 31, and 41 are in independent form.

The Enablement Rejections

Each of claims 5, 15, 25, and 35 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. These rejections are respectfully traversed.

The rejection states that "[r]eferring to claims 5, 15, 25 and 35, applicant recites the blocking signal is transmitted during at least one reply message. However, claims 1, 11, 21, and 31 disclosed the blocking signal is transmitted to a non-enhanced STA, and claims 4, 14, 24, and 34 recites the reply message is transmitted to the MC STA. And MC STA is defined as a enhanced station in claims 1, 11, 21, and 31. Therefore it is not enabling for the blocking signal to

be transmitted during at least one reply message because the blocking signal to be transmitted during at least one reply message because the blocking signal is transmitted to a non-enhanced STA not an enhanced MC STA." This rejection language suggests a potential misunderstanding regarding the proper interpretation of the claims and suggests an improper enablement rejection.

"The problem is to interpret claims '**in view of the specification**'", *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003). *See also* MPEP 2111.01. The Federal Circuit has further held that:

> In order to satisfy the enablement requirement of § 112, paragraph 1, **the specification must enable one of ordinary skill in the art to practice the claimed invention without undue experimentation**. Thus, with respect to enablement the relevant inquiry lies in the relationship between the specification, the claims, and the knowledge of one of ordinary skill in the art. If, by following the steps set forth in the specification, one of ordinary skill in the art is not able to replicate the claimed invention without undue experimentation, the claim has not been enabled as required by § 112, paragraph 1.

National Recovery Technologies, Inc., v. Magnetic Separation Systems, Inc., 166 F.3d 1190, 49 USPQ2d 1671 (Fed. Cir. 1999).

Regarding claims 5, 15, 25 and 35, it is inappropriate to import the claim limitation recited by the present Office Action of "the blocking signal is transmitted to a non-enhanced STA". Likewise it is inappropriate to import the claim limitation recited by the present Office Action of "the reply message is transmitted to the MC STA". It is also improper to rely only on what is disclosed in the other claims to find enablement for claims 5, 15, 25 and 35. Instead, the specification as a whole must be considered.

The specification recites that the "present invention provides a way for enforcing traffic/capacity allocation on an HN communication medium." See Paragraph 09. One skilled in the art would instantly recognize that a "communication medium" can connect a plurality of communication devices that might compete for "traffic/capacity allocation on an HN communication medium".

Each of claims 5, 15, 25 and 35 recite, "masking the IFG to a non-enhanced STA via a blocking signal transmitted during at least one IFG between enhanced frames, the IFG not masked to the second enhanced STA." None of these claims restrict a number of devices or a type of device that can receive the "blocking signal". Consequently, Applicant respectfully submits that the rejection language stating "[t]herefore it is not enabling for the blocking signal to be transmitted during at least one reply message because the blocking signal to be transmitted during at least one reply message because the blocking signal is transmitted to a non-enhanced STA not an enhanced MC STA" inappropriately imports non-existent limitations into the claimed subject matter of at least claims 5, 15, 25 and 35.

Thus, reconsideration and withdrawal of these rejections is respectfully requested.

The Obviousness Rejections

Each of claims 1-40 was rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (U.S. Patent No. 6,922,407). These rejections are respectfully traversed.

A. Claim Construction

On 12 July 2005, the *en banc* Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction **'in light of the specification as it would be interpreted by one of ordinary skill in the art'**";
2. the words of a claim "are generally given their ordinary and customary meaning";
3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application";

4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification";
5. even "the context in which a term is used in the asserted claim can be highly instructive";
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**";
7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents";
8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office"; and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent."

In the present Application, the customary meaning for the phrase "Media Control Station (MC STA)" is implicitly defined in the specification and the cited art. That definition must control examination of those claims that recite this phrase.

At least at page 2, the specification of the present Application implicitly defines the term "Media Control Station (MC STA)" by stating that:

> The MC STA includes a QoS management entity (QME) and an admission control entity (ACE). The QME receives at least one end-to-end QoS message characterizing a user application that includes at least one QoS parameter set that is expressed at a layer that is higher than the Media Access Control (MAC) sublayer of an HPNA v2 network and that is to be passed down to the MAC sublayer of the MC STA for enabling QoS traffic transport of the application. The ACE performs an admission control decision relating to the application based on the at least one end-to-end QoS message characterizing the application. The MC STA transmits a first message to a selected non-MCSTA that is

contained in an enhanced frame having timing to allow an Inter-FrameGap (IFG). The MC STA transmits a blocking signal, such as a sine wave signal and a cosine wave signal.

See Paragraph 14.

Thus, the phrase "Media Control Station (MC STA)" should be construed as one of ordinary skill in the relevant art would interpret the definition provided in the specification.

B. *Prima Facie* Criteria

The cited portions of Wu do not establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP § 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

C. Missing Claim Limitations

a. Claims 1, 11, 21, and 31

Inter alia, each of independent claims 1, 11, 21, and 31 recite, yet the recited portions of Wu do not expressly or inherently teach or suggest, "**masking the IFG to a non-enhanced STA via a blocking signal transmitted during at least one IFG between enhanced frames, the IFG not masked to the second enhanced STA**".

Inter alia, each of independent claims 1, 11, 21, and 31 recite, yet the recited portions of Wu do not expressly or inherently teach or suggest, "**each enhanced STA provided**

preferential access, with respect to non-enhanced devices compliant with said HPNA, to a Home Networking communications medium by said MC STA".

Consequently, for at least the reasons mentioned above, the recited portions of Wu do not teach or suggest all of the claim limitations, and thus does not establish a *prima facie* case of obviousness. Reconsideration and withdrawal of these rejections is respectfully requested.

b. Claims 2, 4, 6, 9, 12, 14, 16, 19, 22, 24, 26, 29, 32, 34, 36, and 39

Inter alia, each of independent claims 2, 4, 6, 9, 12, 14, 16, 19, 22, 24, 26, 29, 32, 34, 36, and 39 recite a "**Media Control Station (MC STA)**". The phrase "**Media Control Station (MC STA)**" is defined in the specification as indicated above in section A. The recited portions of Wu do not expressly or inherently teach or suggest a "**Media Control Station (MC STA)**".

The present Office Action makes a legally erroneous assertion that":

> "Wu's system is capable of having any compliant devices to be connected to his system, and having any combination of station to transmitting and receiving frames. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have a variety of devices (MC STA, non-MC STA, and non-enhanced STA) to be connected to Wu's system because these devices are all compliant with Wu's system."

See Page 4.

The mere assertion that a "Media Control Station (MC STA)" could be "connected to his system" is legally insufficient to show that the recited portions of Wu expressly or inherently teaches or suggests a "Media Control Station (MC STA)" as defined in the specification.

Consequently, for at least the reasons mentioned above, the recited portions of Wu do not teach or suggest all of the claim limitations, and thus does not establish a *prima facie* case of obviousness. Reconsideration and withdrawal of these rejections is respectfully requested.

D. Obviousness Summary

Thus, even if combinable or modifiable, the cited portions of the relied upon references do

not expressly or inherently teach or suggest every limitation of the claims.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:

> "none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 1-40 are allowable because none of the references of record alone or in combination disclose or suggest 'masking the IFG to a non-enhanced STA via a blocking signal transmitted during at least one IFG between enhanced frames, the IFG not masked to the second enhanced STA' and 'each enhanced STA provided preferential access, with respect to non-enhanced devices compliant with said HPNA, to a Home Networking communications medium by said MC STA'".

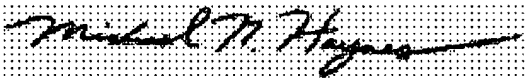
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 30 January 2006

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